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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT M. WILLIAMS

Appeal 2009-006143
Application 10/729,490¹
Technology Center 3600

Decided: December 14, 2009

Before LINDA E. HORNER, SCOTT R. BOALICK, and
STEVEN D. A. MCCARTHY, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed December 5, 2003. The real party in interest is the inventor, Scott M. Williams.

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-4, all the claims pending in the application. Claims 5-18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to a cockpit windshield with photosensitive glass that automatically converts from a transparent state to a dark state. (Spec. Abstract.)

Claim 1 is exemplary:

1. A method for a photosensitive cockpit windshield of the type suitable for use with airplanes, comprising the steps of:

(a) providing a photosensitive portion of a windshield which automatically changes from a transparent state to a darker state in response to varying light conditions; and

(b) adjusting the light sensitivity of said photosensitive windshield, said photosensitive portion being surrounded by an area of said windshield not being photosensitive.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|---------|-----------|---------------|
| Dockery | 3,695,681 | Oct. 3, 1972 |
| Wolf | 4,893,908 | Jan. 16, 1990 |

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Dockery.²

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being obvious over Wolf and Dockery.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

With respect to claim 1, Appellant argues that Dockery does not teach or suggest all the claim features. (Br. 7-8.) In particular, Appellant argues that Dockery does not teach or suggest “a photosensitive portion of a windshield” because “[w]hile the transparency, or visibility, of the window in Dockery might be altered as the window is defrosted, the apparatus therein is not a ‘photosensitive’ window, but one that is sensitive to heat, or temperature – not light.” (Br. 7.) Appellant further argues that Dockery does not teach or suggest “said photosensitive portion being surrounded by an area of said windshield not being photosensitive” because “[e]lements 18, 20, 22 . . . [of] Dockery . . . would appear to represent non-transparent window panes, or other non-transparent window borders, which are not, by definition, either a ‘window’ or a ‘windshield.’” (Br. 8.)

² Claims 5-18 were cancelled in an Amendment filed concurrently with the Appeal Brief on November 13, 2006.

Appellant presents similar arguments with respect to the rejection of claim 1 over the combination of Wolf and Dockery. (Br. 8-9.)

Appellant's arguments present the following issue:

Has Appellant shown that the Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a)?

The resolution of this issue turns on the following subsidiary issues:

1. Has Appellant shown that the Examiner erred in finding that Dockery teaches or suggests "a photosensitive portion of a windshield," as recited in claim 1?

2. Has Appellant shown that the Examiner erred in finding that Dockery teaches or suggests "said photosensitive portion being surrounded by an area of said windshield not being photosensitive," as recited in claim 1?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Dockery

1. Dockery relates to "a heated, self-defrosting tinted [automotive] windshield whose transparency is automatically variable." (Col. 1, ll. 5-7.) A windshield assembly 10 includes an outer or front window pane 18, a rectangular front frame 22, an elastic frame 26 and a movable inner window pane 24. (Col. 1, ll. 62-68; figs. 1, 2.) Figure 2 illustrates that the rectangular front frame 22 is located on an exterior portion of a vehicle. A compartment 36 is defined by the

- space between the rectangular front frame 22, the elastic frame 26 and the movable inner window pane 24. (Col. 2, ll. 8-11.) Movement of the inner window pane 24 is controlled by two upper hydraulic cylinders 47 and two lower cylinders 48. (Col. 2, ll. 24-26.)
2. “A tinted liquid [34] which serves as a light filter is circulated between the panes [18 and 24]” (col. 1, ll. 31-32; fig. 2) in the compartment 36 by a pump 70 (col. 2, ll. 43-44). The liquid 34 can be tinted different colors (col. 2, ll. 12-13) and also heated (col. 1, l. 33). Figure 2 illustrates that an unreferenced outer peripheral region of the inner window pane 24 directly abuts the elastic frame 26 but is separate (i.e., laterally spaced) from the compartment 36 containing the tinted liquid 34.
 3. A photoelectric cell 67 controls movement of the inner window pane 24. (Col. 2, ll. 40-42.) “[W]hen ambient light falling on the photoelectric cell [67] decreases, the transparency of the windshield is automatically increased.” (Col. 3, ll. 47-49.) This is achieved by moving the inner window pane 24 towards the front window pane 18. (Col. 3, ll. 43-46.) As a result, this movement “reduce[s] the quantity of tinted liquid in [the] chamber 36 and thus increase[s] its transparency.” (Col. 3, ll. 45-47.) “[T]he photoelectric cell . . . operates the transparency controlling hydraulic system automatically.” (Col. 4, ll. 5-7.)

Wolf

4. Wolf relates to “decreasing radiative heat transfer and adjustably limiting visible light and near infrared radiation transfer and glare through a window.” (Abstract.) Wolf describes that for automobile or aircraft windows, adjustable light transmission is desired. (Col. 1, ll. 50-51.)

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007).

ANALYSIS

We find no merit in Appellant’s arguments that the Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a).

§ 102/103 Rejection - Dockery

Appellant's arguments (Br. 7-8) that Dockery does not teach or suggest the limitations "a photosensitive portion of a windshield" and "said photosensitive portion being surrounded by an area of said windshield not being photosensitive," as recited in claim 1, are not persuasive.

Regarding the limitation "a photosensitive portion of a windshield," the Examiner cited Dockery for the disclosure of a windshield assembly in which the transparency of the windshield is controlled by a photoelectric cell 67. (Ans. 3; FF 1-3.) Regarding the limitation "said photosensitive portion being surrounded by an area of said windshield not being photosensitive," the Examiner also cited Dockery for the disclosure of a rectangular front frame 22. (Ans. 3.) The Examiner further found that "windshields can be used in any desired elements such as trains, buildings, etc." and "[t]hus it would have been obvious . . . to use the windshield in any area that would be helpful." (Final Office Action mailed Mar. 10, 2006, at p. 3.) The Examiner concluded that claim 1 was anticipated by, or in the alternative, would have been obvious over Dockery. (*Id.* at 2-3; Ans. 3.) We generally agree with the Examiner.

First, Appellant's argument (Br. 7) that Dockery does not teach or suggest the limitation "a photosensitive portion of a windshield," is unconvincing. Dockery teaches a windshield assembly including a front window pane 18 and a movable inner window pane 24 with a tinted liquid 34 circulated in a compartment 36 between the two panes. (FF 1-2.) The distance between the front window pane 18 and the movable inner window pane 24 is controlled by a photoelectric cell 67. (FF 3.) By reducing the volume of the tinted liquid 34 within the compartment 36, the

transparency is increased. (*Id.*) Thus, because the transparency of the tinted liquid 34 is controlled by the photoelectric cell 67, Dockery teaches “a photosensitive portion of a windshield.”

Therefore, Appellant has not shown that the Examiner erred in finding that Dockery teaches or suggests “a photosensitive portion of a windshield,” as recited in claim 1.

Second, Appellant’s argument (Br. 8) that Dockery does not teach the limitation “said photosensitive portion being surrounded by an area of said windshield not being photosensitive,” is unconvincing. Under the broadest reasonable interpretation, we agree with the Examiner that Dockery teaches the limitation “said photosensitive portion being surrounded by an area of said windshield not being photosensitive.” A relevant plain meaning of “windshield” is “a shield that protects against the wind.” *Webster’s Third New International Dictionary* 2621 (1993). Dockery teaches that the windshield assembly 10 includes the rectangular front frame 22, which is located on an exterior portion of a vehicle. (FF 1.) In other words, the rectangular front frame 22 is a portion of the vehicle that protects it against the wind. Thus, we find the Examiner’s construction of “windshield” to be reasonable. Appellant has not pointed to any special definition of “windshield” in the Specification that would require a different interpretation.

Even if Dockery’s non-transparent rectangular front frame 22 were not considered a “windshield,” Dockery teaches that an outer peripheral region of the inner window pane 24 directly abuts an opaque elastic frame 26 and is laterally spaced from the compartment 36 containing the tinted

liquid 34. (FF 2.) Thus, this peripheral region of the inner window pane 24 corresponds to “an area of said windshield not being photosensitive.”

Therefore, Appellant has not shown that the Examiner erred in finding that Dockery discloses or suggests “an area of said windshield not being photosensitive,” as recited in claim 1.

We conclude that Appellant has not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a). Because Appellant has not presented arguments regarding claims 2-4, we affirm the rejection of these claims under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) for the same reasons as claim 1, from which they depend.

§ 103 Rejection – Wolf/Dockery

Appellant’s arguments (Br. 8-9) that claims 1-4 are not obvious over Wolf and Dockery are not persuasive.

The Examiner found that Wolf teaches an airplane windshield. (Final Office Action mailed Mar. 10, 2006, at p. 3.) The Examiner acknowledged that Wolf does not teach or suggest “a photosensitive portion of a windshield” and “said photosensitive portion being surrounded by an area of said windshield not being photosensitive” and cited Dockery for the disclosure of these limitations. (*Id.* at 3-4.) The Examiner concluded that claim 1 would have been obvious over Wolf and Dockery. (*Id.* at 4.) We generally agree with the Examiner.

Appellant argues that Dockery’s “means for varying the transparency of the windshield (or window) . . . would appear to be dependent upon heat, rather than light” and “neither Dockery nor Wolf *et al.*, considered

separately or in combination with one another, teaches or suggests that only a ‘portion’ of a window or windshield should include a photosensitive area.” (App. Br. 9.) However, as discussed above, Dockery teaches or suggests the limitations “a photosensitive portion of a windshield” and “said photosensitive portion being surrounded by an area of said windshield not being photosensitive.”

Therefore, Appellant has not shown that the Examiner erred in finding that the combination of Wolf and Dockery teaches or suggests “an area of said windshield not being photosensitive” and “said photosensitive portion being surrounded by an area of said windshield not being photosensitive,” as recited in claim 1.

We conclude that Appellant has not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Because Appellant has not presented arguments regarding claims 2-4, we affirm the rejection of these claims under 35 U.S.C. § 103(a) for the same reasons as claim 1, from which they depend.

CONCLUSION

Based on the findings of fact and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-4 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a).

DECISION

The rejection of claims 1-4 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a) is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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